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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,008	09/11/2003	Oliver K. Ban	AUS920030422US1	1816
46242 7590 03/16/2007 JANIS E. CLEMENTS 3112 LOMITA DRIVE AUSTIN, TX 78738			EXAMINER WANG, LIANGCHE	
			ART UNIT 2155	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 03/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/660,008

Applicant(s)

BAN, OLIVER K.

Examiner

Liang-che Alex Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/31/2005, 9/11/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Paper Submitted

2. It is hereby acknowledged that the following papers have been received and placed of record in the file:

- a. **Information Disclosure Statements** as received on 1/31/2005, and 9/11/2003 are considered.

Claim Objections

3. Claims 6, 7, 13, 14, and 20 are objected to because of the following informalities:
4. Claims 6 and 20, line 3, recites the limitation "... data object **is** a separate file folder..." should be corrected to "... data object **in** a separate file folder..."
5. Claim 13, line 3, recites the limitation "... data object **is in** a separate file folder..." should be corrected to "... data object **in** a separate file folder..."
6. All dependent claims are objected to as having the same deficiencies as the claims they depend from.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to software per se, which does not fall into the categories of “process”, “machine”, “manufacture” and “composition of matter”. Referring to claim 15, claim 15 recites a computer program having code recorded on a computer readable medium, and then described a sending terminal comprising instructions which renders the sending terminal a software. And since there is no association between the sending terminal and the computer program stored on a computer readable medium, the sending terminal directs the claim to software per se.
9. All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Referring to claims 9-14. Claims 9-14 depends either directly or indirectly on claim 8, and claim 8 recites a method claim. Claims 9-14 recite the limitations of “The electronic

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mail communication network of claim ...”, which render the claims vague and indefinite.

The electronic mail communication network is part of the description in claim 8, however the limitation in the dependent claim should depends on the method of claim 8. The limitations of claims 9-14 are viewed as “The method of claim ...” for further examination.

13. Referring to claim 15, claim 15 recites the limitation in the preamble “A computer program having code recorded on a computer readable medium for fast communication with a symbol linked object based system in a communication network for electronic mail distribution between data processor controlled interactive display terminals”, and then recite the limitation of “a sending terminal comprising: ...”, which renders the claim vague and indefinite. It’s unclear what is the association between the preamble and the sending terminal. Therefore, the claim is vague and indefinite.
14. Referring to claim 16-20. Claims 16-20 depends either directly or indirectly on claim 15, and claim 15 recites a computer program. Claims 16-20 recite the limitations of “The electronic mail communication network of claim ...”, which render the claims vague and indefinite. The electronic mail communication network is part of the description in claim 15, however the limitation in the dependent claims 16-20 should depend on the computer program of claim 15. The limitations of claims 16-20 are viewed as “The computer program of claim ...” for further examination.
15. All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniell et al., US Publication Number 2004/0068545 A1, hereinafter Daniell.

18. Referring to claim 1, Daniell teaches, in a communication network (page 3 [0040]) for electronic mail distribution between data processor controlled interactive display terminals (page 1 [0001-0002]), a sending terminal (computer 100, figure 1) comprising:
- a. means for storing data as a body (page 4 [0050] lines 8-12, composing email message by entering textual message into the body of the document) and an attachment (page 4 [0052] lines 1-4, a file is added as an attachment) for sending with electronic mail (figure 2, 3, 4, 15 and 17, composing an email with body and attachment, and send to a receiving device corresponds “means for storing data”);
 - b. means for handshaking with a receiving terminal (remote computer 120, page 5 [0059], lines 5-7, page 1 [0003], electronic message is sent to the receiving device (120) from the sending device (100), handshaking occurs when connection established between devices for data transmission);
 - c. means for converting data in the sending terminal into a set of symbols (figure 17, page 6 [0065] lines 8-11, composed email with attachment, received at the

receiving device contains descriptive information which corresponds to “data converted into a set of symbols (descriptive information)) that contain information (name, size type) regarding an object (attached file) to which said data is linked (page 5 [0059] lines 5-10, page 6 [0065], information regarding to the attached file is displayed in the electronic message, such as file name, type and size);

- d. means for transmitting symbols to the receiving terminal (page 5 [0059] lines 5-10, message is received by a user’s electronic message client) without transferring data objects (page 5 [0053], lines 23-28, descriptive information are displayed to the receiver to inform the size of the attached file before transferring the attached file; page 6 [0066], attached file is transferred after the descriptive information is viewed and the file is selected); and
- e. means for transferring the data objects in response to requests by the receiving terminal (page 6 [0066-0068], a command is received from the user of the receiving terminal to save a particular attachment).

19. Referring claim 2, Daniell teaches the electronic mail communication network of claim 1 further comprising: means for determining from said symbols a size of their corresponding data object (page 6 [0065], lines 2-6, figure 17, the symbol 76 KB shows the size of attached word file is determined to be seventy-six kilobytes).

20. Referring claim 3, Daniell teaches the electronic mail communication network of claim 2 further comprising means responsive to a request from the receiving terminal to select a data object from the sending terminal (page 6 [0066], lines 4-5, a command (request) is received from the user of the receiving terminal to save a particular attachment).

21. Referring claim 4, Daniell teaches the electronic mail communication network of claim 3 further comprising means responsive to a request from the receiving terminal to download a data object from the sending terminal (page 6 [0067-0068], after the command (request) is received, a copy of file is saved from the sender to the receiver (downloading)).
22. Referring claim 5, Daniell teaches the electronic mail communication network of claim 3 further comprising means responsive to a request from the receiving terminal to delete a data object from the sending terminal (page 6 [0064] lines 13-17, read window is provided to the user to delete and manage messages and file attachments).
23. Referring claim 6, Daniell teaches the electronic mail communication network of claim 2 wherein: said means for storing a symbol of said data object separately from its corresponding data object in a separate file folder at the sending terminal (page 4 [0045], default attachment directory is the folder that saved the attached file (data object), page 6 lines [0064], information regarding to the attachment is sent to the receiving terminal without the transferring data object, therefore the information are stored in a cache, which is in a separate file folder at the sending terminal).
24. Referring claim 7, Daniell teaches the electronic mail communication network of claim 6 further comprising means for separately transmitting said symbol from said data object (page 6 [0064-0068], information and attached file are transmitted separately).
25. Referring claim 8, Daniell teaches a method for fast communication with a symbol linked object based system in a communication network for electronic mail distribution between data processor controlled interactive display terminals (page 1 [0001-0002]) including the steps of:

- a. storing, at a sending terminal (computer 100, figure 1), data as a body (page 4 [0050] lines 8-12, composing email message by entering textual message into the body of the document) and an attachment (page 4 [0052] lines 1-4, a file is added as an attachment) for sending with electronic mail (figure 2, 3, 4, 15 and 17, composing an email with body and attachment, and send to a receiving device);
- b. handshaking, by the sending terminal (computer 100), with a receiving terminal (remote computer 120, page 5 [0059], lines 5-7, page 1 [0003], electronic message is sent to the receiving device (120) from the sending device (100), handshaking occurs when connection established between devices for data transmission);
- c. converting data in the sending terminal into a set of symbols (figure 17, page 6 [0065] lines 8-11, composed email with attachment, received at the receiving device contains descriptive information which corresponds to “data converted into a set of symbols (descriptive information)) that contain information (name, size type) regarding an object (attached file) to which said data is linked (page 5 [0059] lines 5-10, page 6 [0065], information regarding to the attached file is displayed in the electronic message, such as file name, type and size);
- d. transmitting symbols, from the sending terminal to the receiving terminal (page 5 [0059] lines 5-10, message is received by a user’s electronic message client) without transferring data objects (page 5 [0053], lines 23-28, descriptive information are displayed to the receiver to inform the size of the attached file before transferring the attached file; page 6 [0066], attached file is transferred after the descriptive information is viewed and the file is selected); and

- e. transferring the data objects from the sending terminal in response to requests by the receiving terminal (page 6 [0066-0068], a command is received from the user of the receiving terminal to save a particular attachment).
26. Referring claim 9, Daniell teaches the electronic mail communication network of claim 8 further including the step of determining from said symbols a size of their corresponding data object (page 6 [0065], lines 2-6, figure 17, the symbol 76 KB shows the size of attached word file is determined to be seventy-six kilobytes).
27. Referring claim 10, Daniell teaches the electronic mail communication network of claim 9 further including the step, responsive to a request from the receiving terminal, of selecting a data object from the sending terminal (page 6 [0066], lines 4-5, a command (request) is received from the user of the receiving terminal to save a particular attachment).
28. Referring claim 11, Daniell teaches the electronic mail communication network of claim 10 further including the step, responsive to a request from the receiving terminal, of downloading a data object from the sending terminal (page 6 [0067-0068], after the command (request) is received, a copy if file is saved from the sender to the receiver (downloading)).
29. Referring claim 12, Daniell teaches the electronic mail communication network of claim 10 further including the step, responsive to a request from the receiving terminal, of deleting a data object from the sending terminal (page 6 [0064] lines 13-17, read window is provided to the user to delete and manage messages and file attachments).
30. Referring claim 13, Daniell teaches the electronic mail communication network of claim 9 wherein: said storing of a symbol of said data object is stored separately from its

corresponding data object in a separate file folder at the sending terminal (page 4 [0045], default attachment directory is the folder that saved the attached file (data object), page 6 lines [0064], information regarding to the attachment is sent to the receiving terminal without the transferring data object, therefore the information are stored in a cache, which is in a separate file folder at the sending terminal).

31. Referring claim 14, Daniell teaches the electronic mail communication network of claim 13 further including the step of separately transmitting said symbol from said data object (page 6 [0064-0068], information and attached file are transmitted separately).

32. Referring claim 15, Daniell teaches a computer program having code recorded on a computer readable medium (page 3 [0041]) for fast communication with a symbol linked object based system in a communication network (page 3 [0040]) for electronic mail distribution between data processor controlled interactive display terminals (page 1 [0001-0002]), a sending terminal (computer 100, figure 1) comprising:

- a. means for storing data as a body (page 4 [0050] lines 8-12, composing email message by entering textual message into the body of the document) and an attachment (page 4 [0052] lines 1-4, a file is added as an attachment) for sending with electronic mail (figure 2, 3, 4, 15 and 17, composing an email with body and attachment, and send to a receiving device corresponds "means for storing data");
- b. means for handshaking with a receiving terminal (remote computer 120, page 5 [0059], lines 5-7, page 1 [0003], electronic message is sent to the receiving device (120) from the sending device (100), handshaking occurs when connection established between devices for data transmission);

- c. means for converting data in the sending terminal into a set of symbols (figure 17, page 6 [0065] lines 8-11, composed email with attachment, received at the receiving device contains descriptive information which corresponds to “data converted into a set of symbols (descriptive information)) that contain information (name, size type) regarding an object (attached file) to which said data is linked (page 5 [0059] lines 5-10, page 6 [0065], information regarding to the attached file is displayed in the electronic message, such as file name, type and size);
- d. means for transmitting symbols to the receiving terminal (page 5 [0059] lines 5-10, message is received by a user’s electronic message client) without transferring data objects (page 5 [0053], lines 23-28, descriptive information are displayed to the receiver to inform the size of the attached file before transferring the attached file; page 6 [0066], attached file is transferred after the descriptive information is viewed and the file is selected); and
- e. means for transferring the data objects in response to requests by the receiving terminal (page 6 [0066-0068], a command is received from the user of the receiving terminal to save a particular attachment).

33. Referring claim 16, Daniell teaches the electronic mail communication network of claim 15 further including means for determining from said symbols a size of their corresponding data object (page 6 [0065], lines 2-6, figure 17, the symbol 76 KB shows the size of attached word file is determined to be seventy-six kilobytes).

34. Referring claim 17, Daniell teaches the electronic mail communication network of claim 16 further including means responsive to a request from the receiving terminal for selecting a data object from the sending terminal (page 6 [0066], lines 4-5, a command

(request) is received from the user of the receiving terminal to save a particular attachment).

35. Referring claim 18, Daniell teaches the electronic mail communication network of claim 17 further including means responsive to a request from the receiving terminal for downloading a data object from the sending terminal (page 6 [0067-0068], after the command (request) is received, a copy of file is saved from the sender to the receiver (downloading)).
36. Referring claim 19, Daniell teaches the electronic mail communication network of claim 17 further including means responsive to a request from the receiving terminal for deleting a data object from the sending terminal (page 6 [0064] lines 13-17, read window is provided to the user to delete and manage messages and file attachments).
37. Referring claim 20, Daniell teaches the electronic mail communication network of claim 16 wherein: said means for storing a symbol of said data object separately from its corresponding data object in a separate file folder at the sending terminal (page 4 [0045], default attachment directory is the folder that saved the attached file (data object), page 6 lines [0064], information regarding to the attachment is sent to the receiving terminal without the transferring data object, therefore the information are stored in a cache, which is in a separate file folder at the sending terminal).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by

the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

39. Spielman et al., US Patent Numbers 6,671,355, and 6,560,318, teaches an arrangement for managing notification preferences for notification delivery messages in an IP-based notification architecture, where the information contains the total size and number of attachments.
40. Miller et al., US Patent Numbers 6,421,707, teaches a wireless multi-media messaging communication method and apparatus, where the electronic message contains a size and attachment information.
41. Tada et al., US Publication Number 2003/0041112 A1, teaches, attachment document management information, including attachment file size.
42. Gresham et al., US Publication Number 2005/0124337 A9, teaches a system and method for airborne passenger electronic communication, where an email contains partial information including size data indicative of a size of an e-mail and its attachment.
43. Yao et al., US Publication Number 2003/0187937 A1, teaches, using fuzzy-neural systems to improve email handling efficiency
44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang
March 5, 2007

A handwritten signature in black ink, appearing to read "L. C. Wang", written in a cursive style.